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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,901	05/26/2000	Alfred Glanzmann	GR-32	9952

7590 03/28/2003

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EXAMINER

MACKEY, PATRICK HEWEY

ART UNIT

PAPER NUMBER

3651

DATE MAILED: 03/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/579,901

Applicant(s)

GLANZMANN, ALFRED

Examiner

Patrick H. Mackey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-4, 8-12, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson et al. in view of Koren (EP 0663363A1). Nelson discloses a folded sheet opening device with a transport disc (3) fixedly connected to a shaft of a first opening drum (see Figures 13 and 14) which has an outer elastic support (30c), fastened to a disc body of the transport disc with a screw (see Figure 4), cooperating with a securing disc (29) of a second opening drum (see Figures 13 and 14) to clamp an individual printed sheet (15) between the outer elastic support and the securing disc for transporting the individual printed sheet to a transport device (32). The printed sheet feeder is a gather-stitcher feeder (see col. 1, line 21). Nelson emphasizes the importance of fully controlling the sheets across their entire width to ensure proper positioning of inserts (see col. 3, lines 55-74). Nelson discloses all the limitations of the claims, but it does not disclose that the outer elastic support has an outer bearing layer, a compensation area, a radial compression area, an inner layer, or a plurality of stays formed as ledges or lamellas which are positioned at a slant to a radial line. However, Koren (EP 0663363A) discloses a unitary outer elastic support for a rotating disc (roller). Koren discloses that the outer elastic support includes an outer bearing layer (3), a compensation area (2), a radial compression area (9, 14), an inner layer (20), and a plurality of stays formed as ledges or lamella which are positioned at a slant to a radial line (see Figure 5) for the purpose of controlling the position of sheets by spreading them widthwise. Koren discloses that the compensation area is more elastic in the radial direction than

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the outer bearing layer and that the radial compression area has a thickness at least substantially matching a radial thickness of the outer bearing layer. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to modify Nelson by utilizing the outer elastic support disclosed by Koren for the purpose of controlling the position of sheets by spreading them widthwise.

3. Claims 6-7 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson et al. in view of Koren (EP 0663363A1) as applied to claims 1, 5, and 12 above, and further in view of Tebbe et al. Nelson and Koren together disclose all the limitations of the claims, but they don't disclose that the outer elastic support is made of polyurethane. Rather, they disclose that the outer elastic support is made of rubber. However, Tebbe discloses that polyurethane is an equivalent material known in the art (see col. 11, lines 45-47). Polyurethane is easier to clean than rubber. Therefore, because these two materials were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute polyurethane for rubber for the purpose of providing an easy to clean surface.

Response to Arguments

4. Applicant's arguments filed 3/4/2003 have been fully considered but they are not persuasive.

5. The applicant states that the combination of the references to Nelson and Koren will not result in the disk according to the present invention. However, the applicant has not identified any element of the claimed invention not disclosed by the combination of the references. As

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noted in paragraphs 1-3 above, all the limitations of the claims are disclosed by the combination of Nelson and Koren or by the combination of Nelson, Koren, and Tebbe.

6. In addition, in response to the applicant's statements regarding the Koren reference, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick H. Mackey whose telephone number is (703) 308-0630. The examiner can normally be reached on Tuesday-Friday 7:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on (703) 308-2560. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 746-3750 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

A handwritten signature in black ink, appearing to be 'P. Mackey', written over a rectangular box.

Patrick H. Mackey
Primary Examiner
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March 27, 2003